

**REMARKS**

This Amendment is submitted in response to the Office Action dated June 17, 2004. In the Office Action, the Patent Office rejected Claims 15-17 under 35 U.S.C. §103(a) as being unpatentable over *Jones* (U.S. Patent No. 5,882,667) in view of *Martin et al.* (U.S. Patent No. 1,134,691).

By the present Amendment, Applicant amended Claims 15 and 17. Applicant submits that the amendment to the claims overcomes the rejection thereto as made by the Patent Office and places the application in condition for allowance.

Applicant notes with appreciation that the Patent Office indicated that Claims 9, 11, 14 and 21 are in allowable form, and further indicated that Claim 19 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

With respect to the rejection of Claims 15-17 under 35 U.S.C. §103(a) as being unpatentable over *Jones* in view of *Martin et al.*, Applicant submits that the amendment to the claims overcomes the rejection under 35 U.S.C. §103(a) and places the application in condition for allowance. Notice to that effect is requested.

In the Office Action, the Patent Office asserts:

In regard to Claims 15 and 16, although the *Jones* reference does not disclose [sic] an end cap which is interchangeable between different markers and a connecting chain, attention is directed to the *Martin et al.* reference, which discloses another marker wherein an end cap 15 (which is interchangeable between different markers, see lines 82-85) and a chain 14 are connected to an end of the marker in order to enable the marker to be conveniently supported and stored when not in use.

In regards to Claim 17, the sheath includes an

antimicrobial substance therein and the method as claimed is inherent in the usage of the device described supra.

Independent Claim 15, as amended, requires a marking device accessory kit having a sheath which wraps around the exterior surface of the barrel of the marking device wherein the sheath overlaps onto itself when wrapped around the exterior surface of the marking device. Independent Claim 17, as amended, requires a method of using a marking device having the step of providing a sheath that overlaps onto itself when wrapped around the exterior surface of the barrel and partially covers the exterior surface of the barrel between the first end and the second end wherein the sheath is coated with an antimicrobial substance.

*Jones* teaches a plastic sleeve covering containing an antimicrobial agent to resist or prevent then growth of microbes on the surface thereof, thereby preventing cross-contamination of subsequent users following the use of the item by an infected individual. *Martin et al.* teach a pencil holder designed to support a pencil or other writing device suspended above the top of a table, desk or other surface.

Neither *Jones* nor *Martin et al.*, taken either singly or in combination, teaches or suggests a sheath which wraps around the exterior surface of the barrel of the marking device wherein the sheath overlaps onto itself when wrapped around the exterior surface of the marking device as required by Claim 15. Further, neither *Jones* nor *Martin et al.*, taken either singly or in combination, teaches or suggests the step of providing a sheath that overlaps onto itself when wrapped around the exterior surface

of the barrel and partially covers the exterior surface of the barrel between the first end and the second end wherein the sheath is coated with an antimicrobial substance as required by Claim 17.

*Jones* merely teaches that "a substrate hollow sterile writing pen shaft 1 is preferably injection molded, as is the writing pen shaft cap 2, using a mixture produced from a combination of an antimicrobial agent and a plastic." Additionally, *Jones* teaches that "the groove 10 allows the diameter of the passage 11, centrally located in the rigid, sterile plastic sleeve 8, to enlarge to accept an essentially round non-sterile writing pen 12 thereby presenting the user with a sterile gripping surface 9." Further, *Jones* teaches that "the groove 15 would allow the centrally located passage 14 in the sleeve 16 to enlarge to accept an existing writing pen with a non-round six-sided surface 17, thereby presenting the user with a sterile gripping surface 13." Still further, *Jones* teaches that "a sterile sleeve covering may be made, from the aforementioned mixture, into a plastic sheet 18 which may be rolled into a closed circumference to fit the geometric shape of objects with a regular or irregular surface design, or it may be flattened to cover flat surfaces or curved to fit a curved surface." *Martin et al.* merely discloses "pencil holders designed to support a pencil or other writing device suspended above the top of a table." Therefore, neither *Jones* nor *Martin et al.*, taken either singly or in combination, teaches or suggests a sheath which wraps around the exterior surface of the barrel of the marking device wherein the sheath overlaps onto itself when wrapped around the exterior surface of the marking device as required by Claim 15.

Moreover, one of ordinary skill in the art at the time of Applicant's invention would never have been motivated to combine *Jones* with *Martin et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's marking device accessory kit and method for using a marking device. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988). Moreover, Applicant submits that absolutely no teaching, suggestion and/or incentive exists to combine *Jones* with *Martin et al.* in the manner suggested by the Patent Office. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office,

the resultant combination still lacks the novel structural elements and steps positively recited in Claims 15 and 17, respectively. Namely, neither *Jones* nor *Martin et al.*, taken either singly or in combination, teaches or suggests a sheath which wraps around the exterior surface of the barrel of the marking device wherein the sheath overlaps onto itself when wrapped around the exterior surface of the marking device as required by Claim 15. Further, neither *Jones* nor *Martin et al.*, taken either singly or in combination, teaches or suggests the step of providing a sheath that overlaps onto itself when wrapped around the exterior surface of the barrel and partially covers the exterior surface of the barrel between the first end and the second end wherein the sheath is coated with an antimicrobial substance as required by Claim 17. Accordingly, the rejection of Claims 15-17 by the Patent Office under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Claim 16 depends from independent Claim 15; and Claim 19 depends from independent Claim 17. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional structural elements and novel steps of Applicant's marking device accessory kit and method for using a marking device, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. Further, Applicant submits that neither further search

nor consideration would be necessitated by entry of this Amendment; therefore, entry of this Amendment is proper and should be effected.

If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

  
Respectfully submitted,

  
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**CERTIFICATE OF MAILING**

I hereby certify that this **Amendment After Final** are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 16, 2004.

  
Brian M. Mattson